

### **REMARKS**

Claims 27, 29-46 and 48-52 are pending in the application and all stand rejected.

Reconsideration and allowance of all pending claims is respectfully requested in view of the following:

#### ***Responses to Rejections to Claims – 35 U.S.C. §103***

Claims 27, 29-46 and 48-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raley (U.S. Patent No. 7,073,199) (Raley hereinafter) in view of Platt (U.S. Patent No. 6,987,221) (Platt hereinafter). This rejection is not applicable to the amended claims.

#### ***When combined, the references do not teach the claimed subject matter***

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, it is submitted that the references, alone, or in any combination, at least, do not teach the elements of providing the authorized digital media content via a user interface to a thin media client without performing a digital rights management function on the thin media client, wherein the providing is performed by the personal computer, and wherein the thin media client comprises an input/output (IO) device coupled to the personal computer, as recited in independent claims 27 and substantially recited in independent claims 40 and 46, and defined throughout the specification and figures of the pending application.

The rejection concedes on page 3 of the Office Action mailed April 14, 2008 that "Raley . . . fails to specifically teach that the thin media client comprises an input/output (I/O) device

coupled to the personal computer.” Emphasis added. Similarly, it is submitted that Platt also fails to teach such elements of the pending claims.

The rejection points to column 17, lines 5-27 of Platt for teaching “an analogous auto playlist generation with multiple seed songs, wherein the thin media client comprises an input/output (IO) device coupled to the personal computer.” Emphasis added. This argument is respectfully traversed.

The cited portion of Platt relates to Fig. 15, which includes a computer 1512 and a remote computer 1544.

The computer 1512 includes a processing unit 1514, a system memory 1516, and a system bus 1518. The system bus 1518 couples system components including, but not limited to, the system memory 1516 to the processing unit 1514. The processing unit 1514 can be any of various available processors. Dual microprocessors and other multiprocessor architectures also can be employed as the processing unit 1514.

Column 16, lines 7-14.

Computer 1512 can operate in a networked environment using logical connections to one or more remote computers, such as remote computer 1544. The remote computer 1544 can be a personal computer, a server, a router, a network PC, a workstation, a microprocessor based appliance, a peer device or other common network node and the like, and typically includes many or all of the elements described relative to computer 1512.

Column 17, lines 28-35.

However, as found on page 3 of the pending application the “term thin media client refers to a device that is configured to perform one or more functions using digital media content and is configured to leverage the processing, storage, and buffering capabilities of a computer system.” Page 3, lines 24-27. Emphasis added. In addition,

A principal advantage of this embodiment is that it allows a thin media client to use the resources of a computer system in a home network. The cost and complexity of the thin media client is reduced by having the computer system perform many of the processing and storage functions of the media client. In addition, resources of the computer system not normally found in a media client may enhance the features of the media client.

Page 2, lines 12-17.

Thus, it is submitted that neither the computer 1512, nor the remote computer 1544 of Platt teach a thin media client, as recited in the pending claims and defined throughout the specification and figures of the pending application. In addition, the terms “thin” and “leverage”

are not found in the specification of Platt. Thus, it is also submitted that Platt **could not teach a thin media client configured to leverage the processing, storage, and buffering capabilities of a computer system by having the computer system perform many of the processing and storage functions of the media client.**

In light of the above, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, it is submitted that independent claims 27, 40 and 46 and their respective dependent claims are allowable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

In combining multiple references for a 103 rejection, the Supreme Court has ruled that the "teaching, suggestion, or motivation (TSM) test" still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739. The Court stated that "a patent composed of several elements **is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.** Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a **reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.** This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 1741, emphasis added.

In the present case, the Examiner has not expressed any reason why a person of ordinary skill in art would combine the references in the way the claimed new invention does.

Thus, in the present case it is clear that the USPTO's combination arises solely from hindsight based on the present disclosure without any reason why a person of ordinary skill in the art would combine the references as required by the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claims 27, 40 and 46 and their respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of all pending claims is respectfully requested.

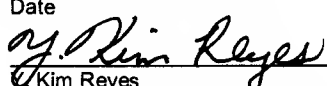
The Office Action contains characterizations of the claims and the related art to which the Applicant does not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

  
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